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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/117,795	11/10/1998	MITSUO SADO	CU-1758RJS	4079

7590

08/19/2003

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EXAMINER

GARRETT, DAWN L

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 08/19/2003

36

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/117,795

Applicant(s)

SADO, MITSUO

Examiner

Dawn Garrett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 June 2003 and 13 June 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office action is in response to the amendments dated June 5, 2003 and June 13, 2003 (paper nos. 33 and 35 respectively). Claim 1 was amended.
2. The rejection of claims 1-4 under 35 USC 112, first paragraph, set forth in paper no. 32 (mailed December 5, 2003), paragraphs 5-7 is withdrawn due to the amendment of claim 1.
3. The rejections of claims 1-4 under 35 USC 112, second paragraph, set forth in paper no. 32 (mailed December 5, 2003), paragraphs 9-11 are withdrawn due to the amendment of claim 1.
4. The rejection of claims 1-4 under 35 USC 103(a) as obvious over JP 63-069897 set forth in paper no. 32, paragraph 13 is maintained.

### ***Response to Arguments***

5. Applicant's arguments filed June 5, 2003 have been fully considered but they are not persuasive. With regard to the rejection over JP 63-069897 A, applicant states "The currently amended claim has modified the transition term from "comprising" to "consisting essentially of" in order to limit the number of elements which follow the term. In this regard, ethylene glycol monobutyl ether is excluded from the claims of the present invention. This amendment clearly distinguishes the claimed invention from the JP reference. On page 2 of the English translation of the JP, paragraph b, it is noted that ethylene glycol monobutyl ether is a component of the cleaner composition. In addition, the cleaner composition of the JP reference requires the use of one or more

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surfactants that are soluble in cleaner solutions solvents, such as non-ionic surfactants, anionic surfactants and amphoteric surfactants which are effective for alkali-aqueous-solution type cleaning and for solvent type cleaning, the preferred surfactants are non-ionic surfactants and anionic surfactants. The presently claimed invention has no requirement for surfactants.” In response, the examiner submits JP 63-069897 does not require the composition comprise ethylene glycol mono-butyl ether, but rather recites the solvent in a Markush group as a possible solvent. The reference recites as component (b) (see second page of translation) “0.2 to 50 weights parts, and preferably 2 to 20 weight parts, of **one or more** high-boiling solvents selected from ethylene glycol monoethyl ether, diethylene glycol monoethyl ether, ethylene glycol monobutyl ether, **diethylene glycol monobutyl ether**, and **benzyl alcohol**”. In regard to applicant’s statement that the JP composition requires surfactant whereas the present composition does not require surfactant, the examiner notes that “consisting essentially of” is still considered open claim language and allows for the presence of surfactant in the compositions unless applicant shows surfactant materially affects the basic and novel characteristics of the composition. As stated in M.P.E.P. 2111.03: The transitional phrase “consisting essentially of” limits the scope of a claim to the specified materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original). See also *Atlas Powder Co. v. E.I. duPont de Nemours & Co.*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); *In re Janakirama - Rao*, 317 F.2d 951, 137 USPQ 893 (CCPA 1963); *Water Technologies Corp. v. Calco*,

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*Ltd .*, 850 F.2d 660, 7 USPQ2d 1097 (Fed. Cir. 1988). When an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of", applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also *Ex parte Hoffman*, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989). The examiner maintains all components of the instant claims are taught by JP 63-069897 and accordingly JP 63-069897 renders obvious the instant composition.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dawn Garrett whose telephone number is (703) 305-0788. The examiner can normally be reached Monday through Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached at (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.

A handwritten signature in black ink, appearing to read "Cynthia H. Kelly". The signature is fluid and cursive, with the first name "Cynthia" being more prominent than the last name "Kelly".

D.G.  
August 10, 2003

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700